

REMARKS

The Official Action mailed February 19, 2004, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statement filed on July 20, 2001. A further Information Disclosure Statement was submitted on April 21, 2004, and consideration of this Information Disclosure Statement is respectfully requested.

Claims 1-13 are pending in the present application, of which claims 1-3, 6 and 9 are independent. Claims 10-12 have been amended to correct minor matters of form. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 10-12 under 35 U.S.C. § 112, second paragraph. In response to this rejection, the Applicants have amended claims 10-12 in conformance with the Examiner's suggestions. Specifically, claims 10-12 have been amended to provide positive antecedent basis for an electrical device mounted on a vehicle (claim 10), and for an acoustic device mounted on a vehicle (claims 11 and 12). The amendments are merely clarifying in nature, and should not in any way affect the scope of protection afforded the claims for infringement purposes, particularly under the Doctrine of Equivalents. The Applicants respectfully submit that claims 10-12 are definite as amended. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

The Official Action rejects claims 1-13 as obvious based on Japanese Kokai Patent Application No. Sho 60[1985]-243730 to Toru Sakon et al. (Toru). The Applicants respectfully traverse the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. Toru does not teach or suggest at least a specifying means for specifying an action commanded by an operator. The Official Action asserts that the information processor 35 of Toru corresponds with the above-referenced feature of the present invention (page 3, Paper No. 5). The Applicants respectfully disagree and traverse the above assertions in the Official Action.

Toru's invention is a direction input detection method in which the direction information is identified based on an angle created by a straight line connecting start and end points and a reference axis of a touch panel and relative positions of the two points (claim 1, page 1 of the translation of Toru). Thus, the information processor 35 identifies the direction information based on the angle. In other words, the information processor 35 merely detects or calculates the direction information, but does not specify

the action commanded by an operator, as required by the independent claims of the present invention. Toru also does not suggest that the information processor 35 be modified to specify the action commanded by an operator. Therefore, Toru does not teach or suggest at least a specifying means for specifying an action commanded by an operator.

Since Toru does not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Furthermore, MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the present invention.

Specifically, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Toru to achieve the claimed invention. The Official Action concedes that Toru does not teach "the end portions located at four corner areas of said touch panel" (page 4, Paper No. 5). The Official Action asserts that "it would have been obvious to a person of ordinary skill in the art to modify the start and end points of the track of the finger moved by the user as taught by the prior art to achieve the end points located at four corner areas of said touch panel because this would provide a method in which direction information can be input using an image almost identical to the one the user images" (*Id.*). The Applicants respectfully disagree and traverse the above assertions in the Official Action.

The modification suggested by the Examiner is not believed to be an obvious matter. In Toru, as noted above, the direction information is identified based on an

angle created by a straight line connecting start and end points and a reference axis of a touch panel and relative positions of the two points. Thus, in Toru's invention or device, it is sufficient for the movement of an operator's finger on the touch panel to be very short. Toru's device does not need to have end portions located at four corner areas of the touch panel so that the action commanded by the operator is specified based on the movement start end portion and the movement termination end portion, as recited in claims 1-5 and 9-13 of the present invention. In addition, since the Applicants' device handles longer distances of movement of the operator's finger between the two end portions on the touch screen, the present device can be characterized as not determining the movement termination when the finger is left, for example, two seconds from the touch panel (page 26, paragraph [0068]). In particular, the Applicants' device is directed to a grouping operation apparatus in which the operator can command the action without seeing the touch screen (page 27, paragraph [0070]). In the present invention, an operator may very effectively specify an action of the device without seeing the screen by using the movement between the two end portions. Toru does not suggest the desirability of these features of the present invention.

Therefore, the Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify Toru such that a specifying means detects a contact point moved from one end portion of a touch panel to another end portion, with the end portions located at four corner areas of a touch panel.

Even assuming motivation could be found, the Official Action has not given any indication that one with ordinary skill in the art at the time of the invention would have had a reasonable expectation of success when modifying Toru.

The Applicants further contend that even assuming, *arguendo*, that the combination of Toru is proper, there is a lack of suggestion as to why a skilled artisan would use the proposed modifications to achieve the unobvious advantages first recognized by the Applicants. The mere fact that references can be combined or


modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the present application, it is respectfully submitted that the prior art of record, alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



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